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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	
09/394,745	09/15/99	FISHER	D	38-21 (15454)
LARRY M LAVIN JR ESQ MONSANTO COMPANY 700 CHESTERFIELD PARKWAY NORTH BB4F ST LOUIS MO 63167			EXAMINER HM22/1219	SIU, S
			ART UNIT 1631	PAPER NUMBER 5
			DATE MAILED: 12/19/00	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/394,745	FISHER ET AL.
<b>Examiner</b>	<b>Art Unit</b>	
Stephen Siu	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_ .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 8-11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 8-11 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)  
17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 20)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Election/Restrictions***

1. Claims 8-10, drawn to a microarray containing a set of nucleic acid molecules, the set of nucleic acid molecules not fully characterized, classified in class 536, subclass 23.1.
2. Claim 11, drawn to a microarray containing a defined set of nucleic acid molecules, classified in class 536, subclass 23.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1 and 2 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together or if they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions contain different and distinct sets of nucleic acid molecules and therefore have different structures and functions.

Further, Group 1 (claims 8-10) is drawn to a microarray containing a subset of nucleic acid sequences. The subset of nucleic acid sequences, however, are not clearly defined because the subset is recited as containing 1000 nucleic acid molecules, only 100 of them being unique, selected from a group of approximately 400 nucleic acid molecules. It would be an undue search burden to perform a search on every combination of 100 nucleic acid molecules selected from a set of 400 molecules. It is noted that if applicants claim a combination of nucleotide sequences, the presence of one novel and nonobvious sequence within the combination will render the entire combination allowable. However, a combination of nucleotide molecules comprising a

defined group of nucleotide molecules is required. Applications containing claims reciting different combinations of individual nucleotide sequences (as in "a combination of DNA fragments, said combination containing at least thirty different DNA fragments selected from SEQ ID NOS. 1-1000") are subject to a restriction requirement. If Group 1 (claims 8-10) is selected, Applicants are required to select one combination for examination.

If group 1 (claims 8-10) is selected, examination will be restricted to only the elected combination.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### *Inquiries*

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Stephen Siu, whose telephone number is (703) 308-7522. The Examiner can normally be reached from 7:00 a.m. to 3:30 p.m. on weekdays. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028. Papers related to this application may be submitted to Art Unit 1631 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. The Fax number is (703) 308-0294. Please call the Examiner at (703) 308-7522 before the transmission to expedite delivery of the fax. Any inquiry of a general nature

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or relating to the status of this application should be directed to the Group receptionist  
whose telephone number is (703) 308-0196.

Stephen Siu

SD

*John S. Brusca*

**JOHN S. BRUSCA, PH.D**  
**PRIMARY EXAMINER**